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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,650	01/16/2004	James E. Manuel	016295.1559 (DC-05989)	8070
23640	7590	10/19/2007	EXAMINER	
BAKER BOTTS, LLP			PICKETT, JOHN G	
910 LOUISIANA			ART UNIT	
HOUSTON, TX 77002-4995			PAPER NUMBER	
			3728	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

debbie.allen@bakerbotts.com

# Office Action Summary

Application No.

10/759,650

Applicant(s)

MANUEL, JAMES E.

Examiner

Greg Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-12,14,21-23,25,26,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-12,14,21-23,25,26,30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment filed 6 August 2007. Claims 1-6, 8-12, 14, 21-23, 25, 26, 30, and 31 are pending in the application. Claims 7, 13, 15-20, 24, and 27-29 have been canceled. Claims 30 and 31 are new.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

3. Claims 1, 2, 4, 21, 22, 25, 26, 30, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Bertelsen (WO 94/25369 A1; previously provided).

Claims 1 and 30: Bertelsen discloses a breakaway packing system comprising a packing support 1/101 with a top section 1 (quantity two) including eight joint portions 7/8 and a bottom section 101 (quantity two) including eight joint portions 107/108, the joint portions forming eight detachable joints 7/8/107/108 arranged as claimed.

Claim 2: Joints 7/8/107/108 are reusable.

Claim 4 is a product-by-process claim. Bertelsen is fully capable of being coupled by an unspecified, unclaimed automated process.

Claims 21 and 25: Bertelsen discloses a breakaway apparatus for retaining a six-sided apparatus and comprising a first upper packing support 1 including an elongated c-shaped member (portions 3 and 4, see Figure 1) with at least one arm 6 extending perpendicularly from the elongated central portion, a first lower packing

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support 101, at least eight detachable joints 7/8/107/108 located against at least four sides (any of which may be considered a first, third, or fifth side since such notation is merely an arbitrary numbering of the sides) of the retained article. Bertelsen is capable of functioning as claimed.

Claim 22: Bertelsen discloses two upper supports 1.

Claim 26: Portions 5 have rounded edges and therefore may be considered curved arms.

Claim 31: Bertelsen discloses a breakaway apparatus for retaining a six-sided apparatus and comprising a first upper packing support 1 including an elongated c-shaped member with a central portion 3 and curved arm members 4 (portions 4 have rounded edges and therefore may be considered curved), a first lower packing support 101 including an elongated c-shaped member with a central portion 103 and curved arm members 104 (portions 104 have rounded edges and therefore may be considered curved), and at least eight detachable joints 7/8/107/108 that are capable of functioning as claimed. The numbering of the corners is arbitrary with the upper supports each receiving two corners and the lower supports each receiving two corners, any pair of which may be considered first and second, or third and fourth corners.

### ***Claim Rejections - 35 USC § 103***

4. Claims 3 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertelsen (WO 94/25369 A1; previously provided).

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Bertelsen, as applied to claims 1 and 21 above, discloses the claimed invention except for the foam material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the packing system of Bertelsen in a foam material in order to cushion the retained item. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

5. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertelsen (WO 94/25369 A1; previously provided), as applied to claim 1 above, and further in view of Gale (GB 2246115 A; previously provided).

Claims 5 and 6: Bertelsen, as applied to claim 1 above, discloses the claimed invention except that it uses conical joints instead of die-cut dovetail joints. Gale shows that die-cut dovetail joints was an equivalent structure known in the art for use as detachable packing joints. Therefore, because these two joining means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the die-cut dovetail joints of Gale for the conical joints of Bertelsen; such a substitution would predictably function to join the two packing system portions. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

6. Claims 8-10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art Figure 1 of the instant application (hereinafter PA1) in view of Bertelsen (WO 94/25369 A1; previously provided).

Claim 8: PA1 discloses the provision of a computer system 9 packaged within a packaging support and shipping container 2, the packing support comprising a top section 6 and a bottom section 4. PA1 does not expressly disclose the specifics of the computer system or the detachable joints.

As to the computer system, applicant has admitted that the provision of a printed circuit board, processor, memory, and chassis within a computer system was common and conventional and their provision within the computer system of PA1 would have been obvious.

Bertelsen discloses a breakaway packing system comprising a packing support 1/101 with a top section 1 (quantity two) including eight joint portions 7/8 and a bottom section 101 (quantity two) including eight joint portions 107/108, the joint portions forming eight detachable joints 7/8/107/108 arranged as claimed. Bertelsen shows that a packaging system with detachable joints was an equivalent structure known in the art for use in packing electronic components. Therefore, because these two packing means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the detachable joint system of Bertelsen for the packing system of PA1; such a substitution would predictably function to securely retain and cushion the retained computer system. An express suggestion to substitute one equivalent component or process for another is

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not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Claim 9: Joints 7/8/107/108 are reusable.

Claim 10: PA1-Bertelsen, as applied to claim 8 above, discloses the claimed invention except for the foam material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the packing system of PA1-Bertelsen in a foam material in order to cushion the retained item. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 12 is a product-by-process claim. PA1-Bertelsen is fully capable of being coupled by an unspecified, unclaimed automated process.

7. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over PA1-Bertelsen as applied to claim 8 above, and further in view of Gale (GB 2246115 A; previously provided).

PA1-Bertelsen as applied to claim 8 above, discloses the claimed invention except that it uses conical joints instead of die-cut dovetail joints. Gale shows that die-cut dovetail joints was an equivalent structure known in the art for use as detachable packing joints. Therefore, because these two joining means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the die-cut dovetail joints of Gale for the conical

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joints of PA1-Bertelsen; such a substitution would predictably function to join the two packing system portions. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

### ***Response to Arguments***

8. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Applicant's assertion that claim 26 was not addressed via an art rejection (and by extension making claim 31 now allowable) is without merit since claim 26 was rejected under 35 USC 103(a) in section 4 of the previous Office Action.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Pickett/  
Examiner  
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